

REMARKS

Claim 1 has been amended based on the hydrogen desorption ratio of 0.20% in Example 8 in Table 5, as well as based on the fact that every carbon black used in Examples 1-10 has a hydrogen desorption ratio of 0.20% or more and in view of the disclosure of a hydrogen desorption ratio $> 0.260 - 6.25 \times 10^{-4} \times \text{CTAB}$ (wt%) considered together with a cetyltrimethylammonium bromide adsorption specific surface area (CTAB) of 111-200 m²/g. For example, when the CTAB is 200 m²/g, the hydrogen desorption ratio is greater than 0.135% when calculated from the equation hydrogen desorption ratio $> 0.260 - 6.25 \times 10^{-4} \times \text{CTAB}$ (wt%), and when this hydrogen desorption ratio range (i.e., greater than 0.135%) is considered modified with respect to its lower limit in view of the hydrogen desorption ratio of 0.20% in Example 8 in Table 5, the recited hydrogen desorption ratio of 0.20% or more is obtained as a result.

Entry of the above amendment is respectfully requested.

Art Rejection

On page 2 of the final Office Action of December 30, 2009, claims 1-7 and 10-11 are rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Sakakibara (US 6,197,870).

However, as seen from the declaration of Mr. Yanagioka executed February 22, 2010 and filed March 30, 2010, the carbon blacks in Examples 4-7 of Sakakibara (US 6,197,870) do not satisfy either of (1) a hydrogen desorption ratio $> 0.260 - 6.25 \times 10^{-4} \times \text{CTAB}$ (wt%) or (2) a toluene tinting permeability of not less than 90%.

Further, as seen from the declaration of Mr. Yanagioka executed February 22, 2010, the carbon black prepared according to Example 5 of Sakakibara (US 6,197,870) has a toluene tinting permeability of 98% and a hydrogen desorption ratio of 0.16%, which is far from the hydrogen desorption ratio of 0.20% that is defined in the above amended claim 1.

Therefore, Sakakibara fails to disclose or suggest the carbon black used in the present invention, and thus the present invention is not anticipated by or *prima facie* obvious over Sakakibara.

In further regard to the non-obviousness of the present invention, as seen from Tables 5 and 6 of the present specification, the carbon blacks satisfying (1) a hydrogen desorption ratio of not less than 0.20%, (2) a toluene tinting permeability of not less than 90% and (3) a CTAB of 111-200 m²/g (i.e., Examples 1, 2, 3, 4, 5, 7, and 8) are superior to the carbon blacks not satisfying either of (1) a hydrogen desorption ratio of not less than 0.20% or (2) a toluene tinting permeability of not less than 90% (i.e., Comparative Examples 1-7) in wear resistance and/or low heat buildup.

Sakakibara does not teach the effects on wear resistance and low heat buildup due to the hydrogen desorption ratio and the toluene tinting permeability of the carbon black. Therefore, one skilled in the art cannot expect the superior results obtained according to the present invention, and thus the present invention is not obvious for this additional reason.

Consequently, the present invention is neither anticipated by Sakakibara nor obvious over Sakakibara, and withdrawal of this rejection is respectfully requested.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

Thomas M. Hunter / Rg. No 33,725

Thomas M. Hunter
Registration No. 64,676

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: November 30, 2010